

REMARKS

This Application has been carefully reviewed in light of the Office Action mailed July 2, 2002. At the time of the Office Action, Claims 1-44 were pending in this patent application. The Examiner rejects Claims 1-44. Claims 21 and 22 have been amended to make stylistic changes and to more clearly claim what the inventor believes to be the invention. Applicants respectfully submit that these amendments will not require a new search to be conducted and will not necessitate new or different grounds of rejection. Applicants respectfully request reconsideration and favorable action in this case.

Section 102 Rejection

The Examiner rejects Claims 1, 2, 5, 6, 13, and 21-23 under 35 U.S.C. § 102(e) as being unpatentable over U.S. Patent No. 6,167,383, issued to Henson ("*Henson*"). Applicants respectfully request consideration of this rejection of Claims 1, 2, 5, 6, 13, and 21-23 for the following reasons.

First, the Examiner acknowledges "Henson does not explicitly disclose scheduling the product described in the custom order for manufacturing." (Office Action, page 2). The Examiner concludes, however, that "the end result of Henson's online system is the manufacture of a computer system to the customer's specification, and therefore scheduling the computer's manufacture is inherent to Henson's system." (Office Action, pages 2-3). Applicants respectfully traverse the Examiner's position.

"To establish inherency, the extrinsic evidence must make clear that the missing descriptive matter is necessarily present in the thing described in the reference, and that it would be so recognized by persons of ordinary skill. Inherency, however, may not be established by probabilities or possibilities. The mere fact that a certain thing may result from a given set of circumstances is not sufficient." M.P.E.P. § 2112; *See In re Robertson*, 49 U.S.P.Q.2d 1949, 1150-51 (Fed. Cir. 1999). "In relying upon the theory of inherency, the examiner must provide a basis in fact and/or technical reasoning to reasonably support the determination that the allegedly inherent characteristic necessarily flows from the teachings of the applied prior art." M.P.E.P. § 2112; *Ex parte Levy*, 17 U.S.P.Q. 1461, 1464 (Bd. Pat. App. & Inter. 1990). In rejecting Claims 1 and 21, the Examiner has not provided a basis to reasonably support the determination that "entering the custom order and order data and

product configuration into an order bank to be scheduled for manufacturing" would be inherent from the teachings of *Henson*.

Second, "[a] claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described in a single prior art reference." *Verdegaal Bros. v. Union Oil Co. of California*, 2 U.S.P.Q.2d 1051, 1053 (Fed. Cir. 1987) MPEP § 2131. Whether considered alone or in combination with any other cited references, *Henson* does not disclose, either expressly or inherently, each and every element of the claims.

Regarding Applicants' independent Claim 1, *Henson* does not disclose, teach, or suggest "generating an order confirmation message and sending the order confirmation message to the user," as recited in Applicants' Claim 1. To the contrary, *Henson* merely discloses an online store that includes a configurator 18, shopping cart 20, checkout 22, and database 24. (Column 4, lines 62-64). The database 24 provides information to the configurator 18, shopping cart 20, and checkout 22. (Column 4, lines 64-66; Figure 1). "Upon completion of a checkout, a customer would be linked to a static thank you page 16. The thank you page 16 provides a message of gratitude to the customer for having placed the order or for visiting the online store." (Column 5; lines 23-27). Thus, *Henson* is limited to nothing more than a static thank you page 16, which concludes the online purchase by conveying a message of appreciation to the customer for his business. The thank you page 16 of *Henson* does not rise to the level of an order confirmation message as included in Applicants' Claim 1. For at least these reasons, *Henson* cannot be said to disclose, teach, or suggest "generating an order confirmation message and sending the order confirmation message to the user," as recited in Applicants' Claim 1. These features are completely absent from *Henson*.

For similar reasons, *Henson* does not disclose, teach, or suggest "an order processor operable to . . . generate an order confirmation message and send the order confirmation message to a user," as recited in Applicants' Claim 21. As described above, *Henson* merely discloses that upon checkout, a customer is linked to a static thank you page 16, which concludes the online purchase. Again, the recited features are completely absent from the online store disclosed in *Henson*. Accordingly, *Henson* also cannot be said to disclose, teach, or suggest each and every feature of Applicants' independent Claim 21.

For at least these reasons, Applicants respectfully submit that the reference relied upon by the Examiner does not anticipate the invention of Applicants' Claims 1 and 21 and respectfully request reconsideration and allowance of Claims 1 and 21.

Dependent Claims 2, 5, 6, 13 and 22-23 that depend upon independent Claims 1 and 21, respectively, are not anticipated by *Henson*, because they include the limitations of their respective independent claim and add additional elements that further distinguish the art. For example, Claim 2 further recites "routing the custom order message to a workflow manager." Similarly, Claim 22 recites "a workflow manager operable to receive the online order from the web server, store order data associated with the online order in a buyer database, and route the online order to the order processor." These features are completely absent from *Henson*. In fact, *Henson* discloses only the steps necessary to submit an order for a customer-configured computer system. *Henson* does not disclose at all how the order is processed after it is submitted, whether processed by a "workflow manager" or otherwise. For at least these reasons, Applicants respectfully request reconsideration and allowance of Claims 2, 5, 6, 13, and 22-23.

Section 103 Rejections

The Examiner rejects Claims 3, 4, 7-12, 19, 20, and 24 under 35 U.S.C. § 103(a) as being unpatentable over *Henson* in view of U.S. Patent No. 6,324,522, issued to Peterson et al. ("Peterson"). For the following reasons, Applicants respectfully request reconsideration of this rejection of Claims 3, 4, 7-12, 19, and 20.

First, the Examiner has not cited language in either reference or within information commonly known to those skilled in the art that provides the necessary motivation or suggestion to combine the teachings of *Henson* and *Peterson*. The mere fact that references can be combined does not render the resultant combination obvious unless the prior art also suggests the desirability of the combination. *In re Mills*, 916 F.2d 680 (Fed. Cir. 1990). The Examiner speculates "it would have been obvious" to make the proposed combination to "provide a means for a manufacturer to track component availability based on the items being ordered online, and thus increase customer satisfaction by accurately indicating item availability and delivery time." (Office Action, page 4). On the contrary, a modification of *Henson* to include the features of *Peterson*, as proposed by the Examiner, would impermissibly change the principle of operation disclosed in *Henson*. If a "proposed

modification would render the prior invention being modified unsatisfactory for its intended purpose, then there is no suggestion or motivation to make the proposed modification." MPEP §2143.01. Also, if a "proposed modification or combination of the prior art would change the principle of operation of the prior art invention being modified, then the teachings of the references are not sufficient to render the claims *prima facie* obvious." MPEP §2143.01. As discussed above, the objective of the system and method disclosed in *Henson* is to provide for the sale of customer-configured computer systems over the internet. For example, *Henson* provides a mechanism for the "**validation of a configuration built by a customer.**" The validation enhancement includes built-in logic which checks the particular configuration built by the customer and indicates whether or not the selected options can be built together for the particular configuration. (Column 7, line 57 through Column 8, line 3). Thus, *Henson* provides for the sale of not yet manufactured computers. Conversely, the objective of *Peterson* is to provide for the inventory management of already manufactured goods. A customer using the system of *Peterson* is limited to ordering items from a **vendor's existing inventory**. Therefore, *Henson* and *Peterson* use different methods for different purposes. For at least these reasons, it would not have been obvious to one of ordinary skill in the art at the time of invention, to combine the online order system of *Henson* with the inventory management system of *Peterson*.

Second, assuming only for purposes of argument that the references may be combined, Applicants have shown above that *Henson* does not recite each and every claim limitation of Claims 1 and 21. Claims 3, 4, 7-12, 19, and 20 depend from Claim 1 shown above to be allowable. Claim 24 depends from Claim 21 also shown above to be allowable. Thus, Claims 3, 4, 7-12, 19, 20 and 24 are allowable for at least these reasons.

In addition, Claims 3, 4, 7-12, 19, 20, and 24 recite further patentable distinctions that are not disclosed by the cited references. By way of example, Claim 3 recites, in part, "sending the custom order data to a dealer selected by the user . . . and routing the custom order message to a B2B server, which sends it to an order processor." *Peterson* discloses a "process for integrating a maintenance supply network with an information network for selectively distributing information about inventory levels and pricing among vendors, and efficiently transferring inventory between parties according to prearranged terms." (Column 1, lines 61-65). To access vendor inventory information, "the user must first be an established customer of the vendor." (Column 21, lines 25-27). The order entry application

enables a user to browse the selected vendor's inventory, pricing, and product availability. (Column 22, lines 50-52). "If the shipping information has been entered, the order will be transmitted to the vendor via the information network." (Column 26, lines 6-10). Thus, an order submitted by a user using the method disclosed in *Peterson* is sent directly to the vendor selected by the user. Further, the *Peterson* method is limited to users who are established customers of the vendor and who have "established a 'buying connection.'" (Column 8, lines 22-25). Accordingly, the order submitted in *Peterson* is not routed "to a B2B server, which sends it to an order processor," as recited in Claim 3.

As further examples, Claim 7 recites "receiving a user-tagging of a particular product from the list . . . and generating a tag order confirmation message and sending the tag order confirmation message to the user." Claim 8 recites "routing the tag order message to a workflow manager." These features are completely absent from the *Henson-Peterson* combination. As is disclosed in *Peterson*, the results of a search "will be displayed in the Dynamic area of the page . . . [T]he user scrolls through the display list until the user finds the item that the user wishes to buy." (Column 32, lines 31-55). After selecting the item, *Peterson* provides:

[I]n a step 36 the information network is provided with the capability transferring an invoice electronically. When a vendor has responded to a purchase order for an item by shipping out the item, the data of the purchase order, such as the purchase order number, the name of the customer ordering the item and the customer's address, a list of items ordered and the quantity of each, is readily available. Such information in electronic form can easily be imported into, or rearranged into an electronic invoice, to which the vendor adds a minimal amount of additional information, such as total cost, including taxes, shipping, and handling charges. This invoice can be quickly sent back to the customer via the information network for lower cost and greater speed than conventional mail.

(Column 5, lines 4-17). As such, *Peterson* discloses that an electronic invoice transmitted to the customer after the item in inventory has been shipped is useful in concluding the transaction. Thus, the invoice transmittal of *Peterson* is limited to a shipping confirmation message. Such a shipping confirmation message fails to teach, suggest, or disclose a "tag order confirmation message" as recited in Claim 7. Accordingly, whether considered alone or in combination with any other cited reference, *Peterson* does not disclose, teach, or suggest the elements of Claim 7.

The Examiner has therefore failed to establish a *prima facie* case of obviousness. For at least these reasons, Applicants respectfully request reconsideration and allowance of Claims 3, 4, 7-12, 19, 20, and 24.

The Examiner rejects Claims 13-18 under 35 U.S.C. § 103(a) as being unpatentable over *Henson* in view of *Peterson* and in further view of U.S. Patent No 5,231,267, issued to Matoba et al. ("*Matoba*"). Applicants respectfully request reconsideration of this rejection of Claims 13-18.

First, Applicants have shown above that *Henson* does not recite each and every claim limitation of Claim 1, from which Claims 13-18 depend. Thus, Claims 13-18 are allowable for at least this reason. Second, Claims 13-18 recite further patentable distinctions that are not disclosed by the cited references. For example, Claim 13 recites "receiving a lead request message incorporating lead data and product configuration data submitted by the user . . . and generating a lead confirmation message and sending the lead confirmation message to the user." As another example, Claim 14 recites "routing the lead request to a workflow manager." Claim 15 recites "sending the lead request data to a dealer selected by the user . . . and requesting lead status updates from the dealer."

Applicants respectfully submit that in rejecting Claims 13-18, the Examiner has performed what amounts to a "keyword rejection." It appears that the Examiner simply performed a keyword search to locate the word "lead" in the text of *Matoba* and then uses this word to reject those portions of Claims 13-18 that happen to also include the word "lead." Significantly, however, the keywords are often taken out of context and do not teach, suggest, or disclose the claimed aspects of the present invention.

"Lead" as disclosed in *Matoba* refers to "lead time," i.e., "the number of days estimated as demanded for completion of a product to be manufactured." (Background) Specifically, *Matoba* discloses a system "capable of automatically determining a lead time in consideration of product specifications, appointed date of delivery and production process states and capable of creating a production schedule on a basis of the lead time in an automated manner." (Column 1, line 64 through Column 2, line 3). An examination of the teachings of *Matoba* confirms that *Matoba* cannot be said to disclose, teach, or suggest "a lead request message incorporating lead data and product configuration data submitted by the user," as recited by Applicants' claims. In rejecting Claims 13-18, the Examiner has, therefore, failed to establish a *prima facie* case of obviousness. The Examiner is again

reminded of his duty to consider each and every word of the claims in judging the patentability of Claims 13-18 against the cited references. For at least these reasons, Applicants respectfully request reconsideration and allowance of Claims 13-18.

The Examiner rejects Claims 25-44 under 35 U.S.C. § 103(a) as being unpatentable over *Henson* in view of *Peterson* and *Matoba*, and further in view of U.S. Patent No. 6,041,310, issued to Green et al. ("Green"). Applicants respectfully request reconsideration of this rejection of Claims 25-44.

Regarding Claim 25, Applicants have shown above that *Henson* does not recite each and every claim limitation of Claim 21, from which Claim 25 depends. Thus, Claim 25 is allowable for at least this reason. Accordingly, Applicants respectfully request that the rejection of this claim be withdrawn.

Regarding Independent Claim 26, Applicants respectfully traverse the Examiner's position. Claim 26 recites, in part, "receiving a custom order message . . . submitted by an online user . . . entering the custom order and its associated data into an order bank to schedule the specified vehicle for manufacturing . . . generating an order confirmation message and sending the order confirmation message to the user." Nowhere does the *Henson-Peterson-Matoba-Green* combination disclose, teach, or suggest these aspects of the claimed invention.

As described above with regard to Claim 1, the system of *Henson* does not disclose "generating an order confirmation message and sending the order confirmation message to the user," as recited in Applicants' Claim 26. To the contrary, and as discussed above, *Henson* merely discloses that upon checkout, a customer is linked to a static thank you page 16, which concludes the online purchase. Thus, the recited features are completely absent from the online store disclosed in *Henson*. Additionally, the Examiner admits that "Henson does not explicitly disclose scheduling the product described in the custom order for manufacturing." (Office Action, page 2). The Examiner has not provided a basis to reasonably support the determination that scheduling the product for manufacturing would be inherent from the teachings of *Henson*. *Peterson*, *Matoba*, and *Green*, whether taken alone or in combination, fail to overcome the deficiencies of *Henson*.

For at least these reasons, and for those stated above with respect to Claim 1, Applicants respectfully request reconsideration and allowance of Claim 26. Claim 25 depends from Claim 21 shown above to be allowable. Claims 27-44 depend from Claim 26

shown above to be allowable. For at least these reasons, Applicants respectfully request reconsideration and allowance of Claims 25-44.

CONCLUSION

Applicants have made an earnest attempt to place this case in condition for allowance. For the foregoing reasons, and for other reasons clearly apparent, Applicants respectfully request full allowance of all pending claims.

If the Examiner feels that a telephone conference would advance prosecution of this Application in any manner, the Examiner is invited to contact Samir A. Bhavsar, Attorney for Applicants, at the Examiner's convenience at (214) 953-6581.

Although no fees are believed due, the Commissioner is hereby authorized to charge any fees or credit any overpayment to Deposit Account No. 02-0384 of Baker Botts L.L.P.

Respectfully submitted,

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WHAT IS CLAIMED IS

1. An online method of ordering and purchasing customized products, comprising:

receiving a custom order message incorporating order data and product configuration data submitted by an online user;

storing the order data and product configuration into a buyer database;

entering the custom order and order data and product configuration into an order bank to be scheduled for manufacturing;

generating an order confirmation message and sending the order confirmation message to the user.

2. The method, as set forth in claim 1, further comprising:

receiving input entered on a web page by the user to submit a custom order, including product configuration data;

generating the custom order message incorporating the product configuration data and sending the custom order message to a web server; and

routing the custom order message to a workflow manager.

3. The method, as set forth in claim 2, further comprising:

sending the custom order data to a dealer selected by the user; and

routing the custom order message to a B2B server, which sends it to an order processor.

4. The method, as set forth in claim 1, further comprising generating a unique order number for the custom order.

5. The method, as set forth in claim 1, further comprising:

receiving customer data related to the user from the user; and

storing the customer data in a common membership database.

6. The method, as set forth in claim 1, further comprising:
receiving online payment data from the user for the custom order;
processing the online payment data of the product; and
confirming the online payment processing completion.

7. The method, as set forth in claim 1, further comprising:
displaying a list of product substantially matching product configuration data entered
by the online user;
receiving a user-tagging of a particular product from the list and a tag order message
incorporating tag order data and product configuration data submitted by the user;
storing the tag order data and product configuration into a buyer database;
modifying inventory data in an inventory database associated with the tagged product
to indicate unavailability; and
generating a tag order confirmation message and sending the tag order confirmation
message to the user.

8. The method, as set forth in claim 7, further comprising:
receiving input entered on a web page by the user to submit a tag order, including
product configuration data;
generating the tag order message incorporating the product configuration data and
sending the tag order message to a web server; and
routing the tag order message to a workflow manager.

9. The method, as set forth in claim 8, further comprising:
sending the tag order data to a dealer selected by the user; and
routing the tag order message to a B2B server, which sends it to an order processor.

10. The method, as set forth in claim 7, further comprising generating a unique
order number for the tag order.

11. The method, as set forth in claim 7, further comprising:
receiving customer data related to the user from the user; and
storing the customer data in a common membership database.

12. The method, as set forth in claim 7, further comprising:
receiving online payment data from the user;
processing the online payment data of the product; and
confirming the online payment processing completion.

13. The method, as set forth in claim 1, further comprising:
receiving a lead request message incorporating lead data and product configuration
data submitted by the user;
storing the lead data and product configuration into a buyer database;
generating a lead confirmation message and sending the lead confirmation message to
the user.

14. The method, as set forth in claim 13, further comprising:
receiving input entered on a web page by the user to submit a lead request, including
product configuration data;
generating the lead request message incorporating the product configuration data and
sending the lead request message to a web server; and
routing the lead request message to a workflow manager.

15. The method, as set forth in claim 14, further comprising:
sending the lead request data to a dealer selected by the user; and
requesting lead status updates from the dealer.

16. The method, as set forth in claim 15, further comprising:
receiving a lead status update from the dealer; and
storing the lead status update in a buyer database.

17. The method, as set forth in claim 13, further comprising generating a unique lead number for the lead request.

18. The method, as set forth in claim 13, further comprising:
receiving customer data related to the user from the user; and
storing the customer data in a common membership database.

19. The method, as set forth in claim 1, further comprising:
receiving a cancel custom order request from the user;
deleting a custom order associated with the cancel customer order request from an order bank; and
updating a buyer database to reflect the updated status of the user.

20. The method, as set forth in claim 1, further comprising:
receiving a cancel tag order request from the user;
modifying data associated with the cancelled tag order in an order bank;
modifying data of a product associated with the canceled tag order in an enterprise product availability database; and
updating a buyer database to reflect the updated status of the user.

21. **(Amended)** An online custom product ordering and purchasing system, comprising:

an online user interface operable to provide product configuration and to receive an online order for a product having a specific product configuration;

a web server operable to receive the online order from the online user interface;

an order processor operable to:

receive the online order from the **[workflow manager]** **web server and** process the order; and

generate an order confirmation message and send the order confirmation message to a user; and

an order bank operable to receive the online order and schedule a product having the product configuration specified in the online order for manufacturing.

22. **(Amended)** The system, as set forth in claim 21, further comprising a workflow manager operable to receive the online order from the web server, **[storing]** **store** order data associated with the online order in a buyer database, and **[routing]** **route** the online order to the order processor.

23. The system, as set forth in claim 21, further comprising a common membership database operable to store customer data associated with the online user.

24. The system, as set forth in claim 21, further comprising an order number generator operable to generate a unique order number for each order.

25. The system, as set forth in claim 21, wherein the online order is for customer ordering a vehicle, the specific product configuration comprises make, model, year, color, engine data, and transmission data of the vehicle.

26. A method of ordering and purchasing a vehicle having specific vehicle configuration via the Internet, comprising:

receiving a custom order message incorporating vehicle configuration data, order data, and user data submitted by an online user;

storing the order data, user data and vehicle configuration data into a buyer database;

processing the custom order;

entering the custom order and its associated data into an order bank to schedule the specified vehicle for manufacturing;

generating an order confirmation message and sending the order confirmation message to the user.

27. The method, as set forth in claim 26, further comprising:

receiving input entered on a web page by the user to submit the custom order, including order data, user data, product configuration data;

generating the custom order message incorporating the product configuration data and sending the custom order message to a web server; and

routing the custom order message to a workflow manager.

28. The method, as set forth in claim 26, further comprising:

receiving a user-selection of a dealer;

sending the order data, user data, and vehicle configuration data to the selected dealer; and

routing the custom order message to a B2B server, which sends it to an order processor.

29. The method, as set forth in claim 26, further comprising generating a unique order number for the custom order message.

30. The method, as set forth in claim 26, further comprising:

receiving user data from the user, including name, address, and contact information; and

storing the user data in a common membership database.

31. The method, as set forth in claim 26, further comprising:
receiving online payment data from the user for the custom order;
processing the online payment data of the vehicle; and
confirming the online payment processing completion.

32. The method, as set forth in claim 26, further comprising:
displaying a list of vehicles substantially matching vehicle configuration data entered
by the online user;
receiving a user-tagging of a particular vehicle from the list and a tag order message
incorporating tag order data and the vehicle configuration data;
storing the tag order data and vehicle configuration into a buyer database;
modifying inventory data in an inventory database associated with the tagged vehicle
to indicate unavailability; and
generating a tag order confirmation message and sending the tag order confirmation
message to the user.

33. The method, as set forth in claim 32, further comprising:
receiving input entered on a web page by the user to submit a tag order, including
product configuration data;
generating the tag order message incorporating the vehicle configuration data and
sending the tag order message to a web server; and
routing the tag order message to a workflow manager.

34. The method, as set forth in claim 32, further comprising:
sending the tag order data to a dealer selected by the user; and
routing the tag order message to a B2B server, which sends it to an order processor.

35. The method, as set forth in claim 32, further comprising generating a unique
order number for the tag order.

36. The method, as set forth in claim 32, further comprising:
receiving customer data related to the user from the user; and
storing the customer data in a common membership database.

37. The method, as set forth in claim 32, further comprising:
receiving online payment data from the user;
processing the online payment data of the vehicle; and
confirming the online payment processing completion.

38. The method, as set forth in claim 26, further comprising:
receiving a lead request message incorporating lead data and vehicle configuration
data submitted by the user;
storing the lead data and vehicle configuration into a buyer database;
generating a lead confirmation message and sending the lead confirmation message to
the user.

39. The method, as set forth in claim 38, further comprising:
receiving input entered on a web page by the user to submit a lead request, including
vehicle configuration data;
generating the lead request message incorporating the vehicle configuration data and
sending the lead request message to a web server; and
routing the lead request message to a workflow manager.

40. The method, as set forth in claim 38, further comprising:
sending the lead request data to a dealer selected by the user; and
requesting lead status updates from the dealer.

41. The method, as set forth in claim 38, further comprising:
receiving a lead status update from the dealer; and
storing the lead status update in a buyer database.

42. The method, as set forth in claim 38, further comprising generating a unique lead number for the lead request.

43. The method, as set forth in claim 26, further comprising:
receiving a cancel custom order request from the user;
deleting a custom order associated with the cancel customer order request from an order bank; and

updating a buyer database to reflect the updated status of the user.

44. The method, as set forth in claim 26, further comprising:
receiving a cancel tag order request from the user;
modifying data associated with the cancelled tag order in an order bank;
modifying data of a vehicle associated with the canceled tag order in an enterprise vehicle availability database; and
updating a buyer database to reflect the updated status of the user.